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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/215,421

12/18/1998

PAUL CHANG

16845-3

7395

7590

06/16/2004

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EXAMINER

SCHULTZ, WILLIAM C

ART UNIT

PAPER NUMBER

2664

19

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/215,421

Applicant(s)

CHANG ET AL.

Examiner

William C. Schultz

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-4, 7, 18, 25, 28-30 and 32-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4, 7, 18, 25, 28-30 and 32-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 17, 18.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed on 6/2/2004 does not fully comply with the requirements of 37 CFR 1.98 because:

As admitted in the IDS, four references are not included in the IDS as filed and are needed to make a full consideration of the IDS.

Since the submission appears to be *bona fide*, applicant is given **ONE (1) MONTH** from the date of this notice to supply the above mentioned omissions or corrections in the information disclosure statement. NO EXTENSION OF THIS TIME LIMIT MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b). Failure to timely comply with this notice will result in the above mentioned information disclosure statement being placed in the application file with the noncomplying information **not** being considered. See 37 CFR 1.97(i).

Response to Amendment

The Inventors' Declaration filed on 3/22/2004 under 37 CFR 1.131 is sufficient to overcome the 6,002,671 and 6,064,721 references. Hence, the previous rejection under 103 for all the outstanding claims is withdrawn.

The Declaration of Paul Marshall filed on 3/22/2004 under 37 CFR 1.131 is sufficient to overcome the 6,002,671 and 6,064,721 references. However the declaration casts doubt on the public use aspect of the references, labeled exhibits A-C, in the declaration used to overcome the 6,002,671 and 6,064,721 references. The declaration has 2 key admissions. First, that the declarant admits to having the viewing

party sign a Non-disclosure agreement form ensuring privacy. Second, that the references labeled exhibits A-C, in fact, relate to embodiments of the invention therefore they show all the limitations of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-4,7,18,25,28-30,32-42 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

The declaration of Paul Marshall discloses that the invention had been disclosed via the documents labeled exhibit A, exhibit B and exhibit C. Paul Marshall alleges that the meeting was using a business custom that was considered confidential, proprietary and not publically disclosed and that he believed that the custom was in effect. No evidence has been presented to substantiate that the meeting was confidential, proprietary and not publically disclosed. MPEP 2133.03(c) says that, "a 131 to swear behind a reference may constitute... an admission that an invention was 'complete'". Also:

If the invention was actually reduced to practice before being sold or offered for sale more than 1 year before filing of the application, a patent will be barred. *Vanmoor v. Wal-Mart Stores, Inc.*, 201 F.3d 1363, 1366-67, 53 USPQ2d 1377, 1379 (Fed. Cir. 2000) ("Here the pre-critical date sales were of completed cartridges made to specifications that remained unchanged to the present day, showing that any invention embodied in the accused cartridges was reduced to practice before the critical date. The Pfaff ready for patenting condition is also satisfied because the specification drawings, available prior to the critical date, were actually used to produce the accused cartridges.");

The exhibits disclose that the invention was complete since nothing else from those dates to the filing date shows that the specification did not change with regard to claimed structures like the "an xDSL modem module that attaches removably to the test set." Features that do change are not claimed and so not considered.

Further more, MPEP 2133.03(e)(1) states:

even if there is bona fide experimental activity, an inventor may not commercially exploit an invention more than 1 year prior to the filing date of an application. In re Theis, 610 F.2d 786, 793, 204 USPQ 188, 194 (CCPA 1979).

The "preliminary specifications" as the exhibits are called are considered by the examiner to be commercial exploitation. In the MPEP under the heading "SIGNIFICANT FACTORS INDICATIVE OF 'COMMERCIAL EXPLOITATION'" Activity A discloses "commercial documents" of which the examiner finds that the exhibits fall into this category of activity. Furthermore, under MPEP 2133.03(e)(3):

experimental use "ends with an actual reduction to practice." RCA Corp. v. Data Gen. Corp., 887 F.2d 1056, 1061, 12 USPQ2d 1449, 1453 (Fed. Cir. 1989). If the examiner concludes from the evidence of record that an applicant was satisfied that an invention was in fact "complete,"

Reliance, from the applicants' on the exhibits to antedate the references used in the previous 103 action indicates that the applicants' consider the exhibits to be a "complete" embodiment of the invention.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire ~~THREE~~ MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the ~~THREE-MONTH~~ shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Schultz whose telephone number is 703-305-2367. The examiner can normally be reached on M-F(7-4)(first bi-week) M-Th(7-4)(second bi-week).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 703-305-4366. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William Schultz



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SUPERVISORY PATENT EXAMINER
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